

### **REMARKS/ARGUMENTS**

Claims 1-6 and 8-11 are under examination in the application. Applicants have added claim 78, which is an independent claim specific to the nucleic acid of SEQ ID NO: 62. The Office Action mailed on March 23, 2007 includes the following objections and rejections:

1. The specification is objected to based on a hyperlink at page 49, line 20
2. The specification is also objected to for using an old format for listing the priority.
3. Claims 1-6 and 8-11 are rejected under 35 U.S.C. §102 as being as anticipated by Pagratis ('611), Pagratis ('616) and Rubenfield.

A response to each of these objections and grounds for rejection follows.

#### ***Missing IDS reference.***

Applicants submit herewith the missing reference, WO/0047774. Applicants apologize for the oversight.

#### ***Specification is objected to based on a hyperlink and the Oath/Declarations.***

Applicants have amended the specification to comply with the Action's request regarding hyperlinks. Applicants have also amended the specification to comply with the request relating to the claim of priority.

#### ***Claims 1-6 and 8-11 are rejected under 35 U.S.C. §102(b) as anticipated by Pagratis, et al., U.S. Patent No. 6,346,611.***

The Action also rejects claims 1-6 and 8-11 under 35 U.S.C. § 102(e) as being anticipated by Pagratis, et al. U.S. Patent No. 6,346,611. Applicants respectfully submit that the cited reference fails to meet the standard of 35 U.S.C. § 102(e) namely, teaching all elements of the claimed invention either explicitly or impliedly and every limitation of the present invention.

In order for a rejection under 35 U.S.C. § 102 to be proper, the cited reference must teach each and every aspect of the claimed invention either explicitly or impliedly. See MPEP §2131. As

elaborated in *Richardson v. Suzuki Motor Co.* “[t]he identical invention must be shown in as complete detail as is contained in the claim.” 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1987).

Applicants respectfully submit that claims 1-6 and 8-11 are not anticipated by Pagratis. Pagratis is non-enabling and does not disclose and enable each and every limitation to the present invention; and as such, cannot anticipation the present invention. Pagratis only teaches standard aptamers, that is, nucleic acid aptamers that have all the degradation problems associated with aptamers that have not been thiomodified as described by the present invention. Furthermore, nothing in SELEX teaches the partial thio-modification of aptamers, that is, to modify some but not all of the links in the backbone at specific locations and their isolation and characterization, as described by the present inventors. The Applicants wish to point the examiner to United States Patent No. 6,867,289 by some of the present inventors (and commonly assigned), which teaches and claims the same type of partial thio-modifications as taught and claimed herein. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

***Claims 1-6 and 8-11 are rejected under 35 U.S.C. §102(e) as anticipated by Pagratis, et al., U.S. Patent No. 6,713,616.***

The Action also rejects claims 1-6 and 8-11 under 35 U.S.C. § 102(e) as being anticipated by Pagratis, et al. U.S. Patent No. 6,713,616. Applicants respectfully submit that the cited reference fails to meet the standard of 35 U.S.C. § 102(e) namely, teaching all elements of the claimed invention either explicitly or impliedly and every limitation of the present invention.

In order for a rejection under 35 U.S.C. § 102 to be proper, the cited reference must teach each and every aspect of the claimed invention either explicitly or impliedly. See MPEP §2131. As elaborated in *Richardson v. Suzuki Motor Co.* “[t]he identical invention must be shown in as complete detail as is contained in the claim.” 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1987).

Applicants respectfully incorporate by reference the arguments presented hereinabove in response to Pagratis, et al., U.S. Patent No. 6,346,611. Again, the present invention distinctly claims a structure that is different from that in the ‘611 and ‘616 patents of Pagratis, namely, that

the present invention is directed to partially thio-modified aptamers. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(e).

***Claims 1 and 7 are rejected under 35 U.S.C. §102(e) as anticipated by Rubenfield.***

The Action also rejects claims 1 and 7 under 35 U.S.C. § 102(e) as being anticipated by Rubenfield, et al., U.S. Patent No. 6,551,795. Applicants respectfully submit that the cited reference fails to meet the standard of 35 U.S.C. § 102(e) namely, teaching all elements of the claimed invention either explicitly or impliedly and every limitation of the present invention.

In order for a rejection under 35 U.S.C. § 102 to be proper, the cited reference must teach each and every aspect of the claimed invention either explicitly or impliedly. See MPEP §2131. As elaborated in *Richardson v. Suzuki Motor Co.* “[t]he identical invention must be shown in as complete detail as is contained in the claim.” 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1987).

Applicants respectfully submit that claims 1 and 7 are not anticipated by Rubenfield because it does not disclose and enable each and every limitation to the present invention; and as such, cannot anticipate the present invention. Applicants fail to understand how a nucleic acid that is only 40% related anticipates the present invention. Furthermore, the oligonucleotide of Rubenfield fails to teach both the structure and function of the present invention, namely, partially thio-modified aptamers that are TGF- $\beta$  specific. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(e).

### **CONCLUSION**

In light of the remarks and arguments presented above, Applicants respectfully submit that the claims in the Application are in condition for allowance. Favorable consideration and allowance of the pending claims is therefore respectfully requested.

If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Dated: June 25, 2007

Respectfully submitted,

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